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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/071,664	05/01/98	SHAFER	S 98P7512US

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
186 WOOD AVENUE SOUTH
ISELIN NJ 08830

EXAMINER

BUI, B

ART UNIT

PAPER NUMBER

2642

13

DATE MAILED: 05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/071,664

Applicant(s)

Shaffer et al

Examiner

Bing Bui

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Feb 20, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-19 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-19 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 U.S.C. § 102

1. Claims 1-7 and 9-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Rogers et al (US Pat No. 5,946,386).

Regarding claim 1, respect to fig 1, Rogers et al teach a method for providing an automated call connection system comprising the steps of:

initiating a call back request from a first user to a second user (col 15, ln 35-42; col 37, ln 8-18 and col 44, ln 44-col 45, ln 10);

sending the call back request from the first user to the second user (col 15, ln 35-42; col 37, ln 8-18 and col 44, ln 44-col 45, ln 10);

receiving the call back request (col 15, ln 35-42; col 37, ln 8-18 and col 44, ln 44-col 45, ln 10);

the second user choosing between acceptance and rejection of the call back request (col 15, ln 35-42; col 37, ln 8-18 and col 44, ln 44-col 45, ln 10); and

if the second user chooses to accept the call back request, immediately and automatically attempting to connect the first user and the second user (Fig 6c; col 15, ln 35-42; col 37, ln 8-18 and col 44, ln 44-col 45, ln 10).

Regarding claim 2, Rogers et al teach a method for providing an automated call connection system further comprising the step of using a separate packet-based network to

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determine if the second user is ready to accept the call back request (Figs 1 and 6a-9ab; col 3, ln 56-65; col 4, ln 36-41 and col 11, ln 45-47).

Regarding claim 3, Rogers et al teach a method for providing an automated call connection system further comprising the step of bypassing call toll charges by using a packet-based network for the sending of call back requests (Figs 1 and 6a-9ab; col 3, ln 56-65; col 4, ln 36-41 and col 11, ln 45-47).

Regarding claim 4, Rogers et al teach a method for providing an automated call connection system further comprising the step of utilizing a computer for the sending of the call back requests to a server collecting the call back requests for immediate delivery to the second user (col 11, ln 6-12 and col 15, ln 36-42).

Regarding claim 5, Rogers et al teach a method for providing an automated call connection system further comprising the call back requests are automatically sent via at least one of an E-mail message, a page and a facsimile (Figs 1 and 6a-9ab; col 3, ln 56-65; col 4, ln 36-41 and col 11, ln 45-47).

Claims 6, 11 and 17 are rejected for the same reasons as recited in the rejection of claim 1.

Claims 7, 9, 15-16 and 18 are rejected for the same reasons as recited in the rejection of claim 5.

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Regarding claim 10, Rogers et al teach a method for providing an automated call connection system further comprising a personal digital assistant is used to initiate the call back request (Figs 1 and 6a-9ab; col 3, ln 56-65; col 4, ln 36-41 and col 11, ln 45-47).

Claim 12 is rejected for the same reasons as recited in the rejection of claim 2.

Claim 13 is rejected for the same reasons as recited in the rejection of claim 3.

Claim 14 is rejected for the same reasons as recited in the rejection of claim 4

2. Claims 1 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hsu (US Pat No. 5,661,790).

Regarding claims 1 and 11, respect to fig 2, Hsu teaches a method for providing an automated call connection system comprising the steps of:

initiating a call back request from a first user to a second user (Fig 2 and col 3, ln 58-col 4, ln 4);

sending the call back request from the first user to the second user (Fig 2 and col 3, ln 58-col 4, ln 4);

receiving the call back request (Fig 2 and col 3, ln 58-col 4, ln 4);

the second user choosing between acceptance and rejection of the call back request (Fig 2 and col 3, ln 58-col 4, ln 4); and

if the second user chooses to accept the call back request, immediately and automatically attempting to connect the first user and the second user (Fig 2 and col 3, ln 58-col 4, ln 4).

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Claim Rejections - 35 U.S.C. § 103

3. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al as applied in claims 1 and 11 above, and further in view of Hanson et al (US Pat No. 5,740,229).

Regarding claims 8 and 19, Rogers et al teach the invention substantially as claimed, with the exception of providing the method of:

maintaining a connection between the first user and the second user for a predetermined period of time;

wherein the predetermined period of time is specified by the first user.

However, Hanson et al disclose the invention substantially as claimed, the method of:

maintaining a connection between the first user and the second user for a predetermined period of time (Abstract);

wherein the predetermined period of time is specified by the first user (Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the system and method for maintaining a connection between the first user and the second user for a predetermined period of time specified by the first user as taught by Hanson et al into view of Rogers et al such that the possibility of acceptance for making a return call by called party will be high since called party does not have to pay for the

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return call he made and the main or important elements of conversation can be effectively managed to fit with predefined time constrained .

Response to Arguments

4. Applicant's arguments filed on 02/20/01 have been fully considered but they are not persuasive.

Regarding claims 1 and 11, Applicant argues that neither Rogers nor Hsu teaches the recited claimed invention. Examiner respectfully disagrees due to the following reasons that provide more clarification in addition to the rejection to the recited claims shown in previous Examiner's Office Action:

(1) As to Rogers, he provides a system and method in which a caller have option to leave message in a voice mail accessible by a called party. It is noted that those of ordinary skill in the art will recognize that voice mail feature gives a caller the freedom of expressing whatever he wants the called party to know. Therefore, if he wants called party to call him back or return his call for example, he may just simply say: "Hi X, this Y; please return my call as soon as you could". Called party receives caller's callback request by accessing voice mail system and having the choice of whether or not to accept the caller's request. If caller's request is accepted, using voice mail subscreen, called party may simply click of his mouse, with the system automatically out dialing to corresponding caller (Fig 6c and col 44, ln 44-col 45, ln 10).

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(2) As to Hsu, first subscriber and second subscriber are subscribers of Class Automatic Recall; therefore, call made by first subscriber inherently associates with request for recall or returning call. The local exchange serving the second subscriber stores first subscriber's information in its own database. After the termination of the initial call made by first subscriber, the second subscriber may or may not wish to recall the first subscriber. However, if second subscriber wishes to recall the first subscriber, second subscriber merely enters an appropriate service code and upon receipt of the service code, said local exchange initiates a call setup toward the first subscriber (col 3, ln 58-col 4, ln 4).

Clearly, the recited claimed invention has been anticipated by either Rogers or Hsu based on detailed clarification provided by Examiner cited above.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6306 and for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE") or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

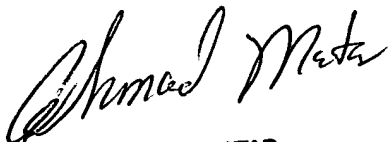
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Bing Bui

Patent Examiner

Apr 25, 2001


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600